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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,564	09/22/2000	Julie T. Dawe	10003368-1	2998

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Intellectual Property Administration
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EXAMINER

LEE, CHEUKFAN

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,564

Applicant(s)

DAWE, JULIE T.

Examiner

Cheukfan Lee

Art Unit

2622

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-17,21,22 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 5-17 is/are allowed.
- 6) ☒ Claim(s) 21,22 and 29 is/are rejected.
- 7) ☒ Claim(s) 25-28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. The finality of the Office action mailed March 10, 2004 is withdrawn due to discovery of new prior art reference applied below.
2. Claims 1, 2, 5-17, 21, 22, and 25-29 are pending. Claims 1, 8, 16, and 21 are independent.
3. The provisional rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application Serial No. 09/696,719 has been withdrawn because copending claim 1 is no longer pending. See Remarks, page 8, lines 23-30, filed May 5, 2004.
4. The indicated allowability of claim 24, now canceled, subject matter of which is incorporated in independent claim 21 in the amendment filed May 5, 2004, is withdrawn in view of the newly discovered reference(s) to Stange (U.S. Patent No. 4,078,786). Therefore, claim 21 is not allowable. Rejections based on the newly cited reference(s) follow.
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2622

6. Claims 21, 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. (U.S. Patent No. 6,043,866) in view of Stange (U.S. Patent No. 4,078,786).

Regarding claim 21, Kawai et al. discloses an original carrier used with an original scanner (col. 3, line 59- col. 9, line 20). The carrier (Figs. 1, 2 and 4-20) has an opaque sheet (1) and a transparent sheet (2). An original to be scanned is placed between the sheets (1 and 2). The carrier has a layout template (within an area of 1) (Figs. 1, 2, 5-8, 12-14, and 17-20) that defines a layout area accommodating at least one object that is to be contained in the produced copy. The carrier is convertible between a layout mode and a duplication mode. In the layout mode, the layout area is observable by a user so that the user may observe an arrangement of the object(s) within the layout area. In the duplication mode, the carrier with the arranged original(s) or object(s) are scanned to produce a copy of the arrangement. Note in Fig. 1 and 2 of Kawai et al., that the cover (2) pivotally mounted to the lower sheet (1) (layout template defining one or at least one layout area) reads on the claimed cover member pivoted between a first position and a second position (closed position). In its opened position, the cover (2) exposes the one or at least one layout area when it is in its open position, and in its closed position, the cover (2) secures the one or at least one object placed in between the sheets (1 and 2). Kawai et al. Does not explicitly disclose making a greeting card using the produced copy of the arranged original(s) or object(s). Since the original or object being reproduced includes a postcard with a photograph, i.e., not just text (Figs. 5-8 and 18), one of ordinary skill in the art would have realized that a

greeting card is produced when such a produced copy is folded. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a greeting card using the produced copy of Kawai et al. by folding the produced copy of the original(s) or object(s) to make variety of uses of the scanner or duplication apparatus.

Although Kawai et al. does not directly suggest making a "greeting card", one of ordinary skill in the art would have realized the fact that a copy or product produced by using the method of Kawai et al. is easily made into a greeting card by, for example, folding the produced copy. It is common knowledge to one of ordinary skill in the art that a printed copy, be it printed out after arranging images on a computer display either by operator manipulation of the images and/or text on display, or printed out from a document scanner which has the capability to arrange or rearrange the scanned in images or a combination of images and text, once folded, become a greeting card.

Referring to the claim(s), a "greeting card" is not defined to be something different from the folded copy discussed above. With the disclosure of Kawai et al. and the common knowledge of one of ordinary skill in the art, using the produced copy of Kawai et al. to provide a greeting card would have been obvious. Therefore, the claimed invention is not patentably distinct from the obvious method of Kawai et al.

The obvious apparatus of Kawai et al. discussed above differs from the claimed invention in that the transparent plastic cover is not of rigid plastic but flexible.

Art Unit: 2622

However, employing a rigid transparent plastic cover (44) for covering, retaining and protecting the document in an image scanning and reproduction operation is taught by Stange (Fig. 5, col. 4, lines 2-10, col. 1, lines 52-62). The cover maintains the document on the planar tray (col. 1, lines 55-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the flexible transparent plastic cover of Kawai et al. with a rigid transparent plastic cover as taught by Stange in order to maintain the document or object on the layout template.

Regarding claim 22, the cover member (upper sheet 2) is provided with at least one opening, provided with elements (2a, 2b, 2c, etc.) (Figs. 6-8, col. 5, lines 22-55).

Regarding claim 29, Kawai et al. further discloses a guideline (tacky 31e in Fig. 20) provided on the lower or opaque sheet (1) (layout template), the guideline defining one layout area (col. 9, lines 10-16).

7. Claims 25-28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 1, 2, 5-7, 9-15, 8, 16 and 17 are allowed.

9. The following is an examiner's statement of reasons for allowance:

Claim 25 would be allowable because the lower sheet (opaque sheet 1) (layout template) of Kawai et al. does not define any opening therein, the opening defining the at least one layout area.

Claim 26 would be allowable because Kawai et al. does not disclose a backing member as claimed in addition to the cover member (2) and the layout template (1).

Claims 27 and 28 depend upon claim 26.

Claim 1 is allowable over the prior art of record because the prior art, including Kawai et al. and Stange, does not disclose that the layout area of the template includes a recessed area in combination with other limitations of claim 1. Claims 2, 5-7, and 9-15 depend upon claim 1.

Claims 8 and 16 were indicated allowed. See previous Office action mailed Sept. 9, 2003. The reasons for allowance are repeated below.

Claim 8 is allowable because Kawai et al. does not disclose a combination of the layout template, the backing member and the transparent cover. In the withdrawn rejections addressed in the Final action dated March 10, 2004, the transparent sheet (2) reads on the backing member in one claim or on the transparent cover in another claim but does not meet both the backing member and the transparent member when both are in the same claim which is claim 8.

Claims 16 and 17 are allowable because Kawai et al. does not disclose an aperture grille operatably associated with the backing a member that defines a layout

Art Unit: 2622

area which accommodates at least one object that is to be contained in a greeting card, the aperture grille including at least one opening therein, in combination with other limitations of claim 16. The template of Kawai et al. is not an aperture grille. Claim 17 depends upon claim 16.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Parulski et al. (U.S. Patent No. 5,285,237) discloses a photoprint retaining platen for digitizing image scanner (Figs. 6 and 7, col. 6, lines 35-53).

Frankel (U.S. Patent No. 3,973,344) discloses a multi-image slide mount.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
May 20, 2004


Cheukfan Lee